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PATENT APPLICATION

ATTORNEY DOCKET NO. ____10008135-1____

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): **Shell Simpson, et al**

Application No.: 10/053,174

Filing Date: **November 13, 2001**

Confirmation No.: 6072

Examiner: Pokrzywa, Joseph R.

Group Art Unit: 2622

Title: **Methods and Systems for Making Booklets**

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on ____04-03-06____.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month $120   ☐ 2nd Month $450   ☐ 3rd Month $1020   ☐ 4th Month $1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of ___$ 500___. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

Shell Simpson, et al

By _[signature]_

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Rev 10/0 (AplBrief)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Shell Simpson, *et al.*)
) Group Art Unit: 2622
Serial No.: 10/053,174)
) Examiner: Pokrzywa, Joseph R.
Filed: November 13, 2001)
) Atty. Docket No.: 10008135-1
For: Methods and Systems for Making Booklets)

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed April 3, 2006, responding to the Final Office Action mailed December 2, 2005 and the Advisory Action mailed February 24, 2006.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 08-2025.

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I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. Status of Claims

Claims 1-8 and 10-28 stand finally rejected. No claims have been allowed. The final rejections of claims 1-8 and 10-28 are appealed.

IV. Status of Amendments

This application was originally filed on November 13, 2001, with twenty-seven (27) claims. In a Response filed September 15, 2005, Applicant amended claims 1, 10, 14, 18, 23, and 25; canceled claim 9; and added claim 28. The claims in the attached Claims Appendix reflect the present state of Applicant's claims.

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V. Summary of Claimed Subject Matter

The claimed inventions are summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Embodiments according to independent claim 1 describe a method comprising receiving (FIG. 1, arrow between item 108 and item 106), via at least one network service (FIG. 2, 166), imaging data that is to be included in a booklet. The method further comprises receiving (FIG. 9, 906), via the at least one network service (FIG. 2, 166), user input for incorporating the imaging data into the booklet and building (FIG. 9, 908), via the at least one network service (FIG. 2, 166), a booklet incorporating imaging data in accordance with the user input. The method further comprises printing (FIG. 9, 910) the booklet on a network-accessible printer designated by user input. Applicant's specification, page 4, lines 11-19; pages 8-11, lines 1-11; page 12, lines 11-18, and page 19, lines 23-35.

Embodiments according to independent claim 10 describe one or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors (FIG. 10, 1002), cause the processors (FIG. 10, 1002) to send content to a client device (FIG. 3, 202) for execution by a client browser (FIG. 3, 204), the content enabling the client device (FIG. 3, 202) to display a user interface (FIG. 4, 240) that is configured to enable a user to select imaging data for use in building a booklet. Page 11, lines 13-15. The content is further enabled to provide, over a network (FIG. 2, 158), a user selection of imaging data for use in building the booklet, page 11, lines 18-19, and provide, over the network (FIG. 2, 158), user input for incorporating the imaging data into the booklet. Page 12, lines 23-24. The content is further enabled to provide, over the network (FIG. 2, 158), user input for designating a network location for printing the booklet. Page 19, lines

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2...-25. Applicant's specification, page 4, lines 11-19; pages 8-11, lines 1-11; page 12, lines 1...-18, page 19, lines 23-35, and pages 23-25, lines 20-14.

Embodiments according to independent claim 14 describe a method comprising causing, via at least one Web service (FIG. 3, 220), a user interface to be presented on a client device the user interface (FIG. 4, 240) being configured to enable a user to select imaging data for use in making a booklet. Page 7, lines 18-25 and page 11, lines 1-10. The method further comprises receiving (FIG. 9, 906), via the at least one Web service (FIG, 3, 220), a user selection of imaging data and receiving, page 11, lines 13-15, via the at least one Web service (FIG. 3, 220), user input for incorporating the imaging data into a booklet. The method further comprises building (FIG. 9, 908), via the at least one Web service (FIG. 3, 220), a booklet incorporating imaging data received from the user input and printing (FIG. 9, 910), via the at least one Web service (FIG. 3, 220), the booklet on a Web-accessible printer (FIG. 3, 224) designated by the user. Applicant's specification, page 4, lines 11-19; pages 8-11, lines 1-11; page 12, lines 11-18, and page 19, lines 23-35.

Embodiments according to independent claim 18 describe a method comprising receiving, page 11, lines 13-15, via at least one Web service (FIG. 3, 220), a user selection of imaging data that is to be used to build a booklet. The method further comprises receiving (FIG. 9, 906), via the at least one Web service (FIG. 3, 220), user input for incorporating the imaging data into the booklet and receiving, via the at least one Web service (FIG. 3, 220), user input for designating a network device (FIG. 3, 224) for printing the booklet. Page 19, lines 23-25. The method further comprises building (FIG. 9, 908), via the at least one Web service (FIG. 3, 220), a booklet incorporating imaging data received from the user input. Applicant's specification, page 4, lines 11-19; pages 8-11, lines 1-11; page 12, lines 11-18, and page 19, lines 23-35.

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Embodiments according to independent claim 22 describe one or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors (FIG. 10, 1002), cause the processors (FIG. 10, 1002) to receive, page 11, lines 13-15, via at least one Web service (FIG. 3, 220), a user selection of imaging data that is to be used to build a booklet. The processors are further caused to receive (FIG. 9, 906), via the at least one Web service (FIG. 3, 220), user input for incorporating the imaging data into the booklet and receive, page 19, lines 23-25, via the at least one Web service (FIG. 3, 220), user input for designating a network device (FIG. 3, 224) for printing the booklet. The processors are further caused to build (FIG. 9, 908), via the at least one Web service (FIG. 3, 220) a booklet incorporating imaging data received from the user input. Applicant's specification, page 4, lines 11-19; pages 8-11, lines 1-11; page 12, lines 11-18, page 19, lines 23-35; and pages 23-25, lines 20-14.

Embodiments according to independent claim 23 describe a booklet-making method comprising browsing (FIG. 9, 904) to a Web-accessible booklet-making service (FIG. 3, 220). The method further comprises specifying to the Web-accessible booklet-making service (FIG. 3, 220) imaging data that is to be used to make a booklet and how that imaging data is to be used. (FIG. 9, 906; page 11, lines 18-19; and page 12, lines 23-24). The method further comprises constructing (FIG. 9, 908), via the Web-accessible booklet-making service (FIG. 3, 220), a booklet incorporating the imaging data and forwarding, page 10, lines 18-21, from the Web-accessible booklet-making service (FIG. 3, 220), the booklet to a network printer (FIG. 3, 224) designated by a user.

Embodiments according to independent claim 25 describe a web service comprising means (FIG. 5, 266), operably associated with the Web, for enabling a user to specify one or more Web-accessible documents for use in building a booklet. The web service further comprises means, operably (FIG. 6, 278) associated with the Web, for enabling the user to

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specify one or more pages from the one or more documents and where the one or more pages will reside in the booklet and means (FIG. 4, 240), operably associated with the Web, for enabling the user to designate a network printer for printing the booklet. The web service further comprises means (FIG. 10, 1000), operably associated with the Web, for building the booklet. Applicant's specification, page 4, lines 11-19; pages 8-11, lines 1-11; page 12, lines 11-18, page 19, lines 23-35, and pages 23-25, lines 20-14.

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejections are to be reviewed on appeal:

Claims 1-8 and 10-28 have been rejected under 35 U.S.C. § 102(b) as allegedly being unpatentable by *Gottfreid* (U.S. Patent No. 6,076,076).

VII. Arguments

The Appellant respectfully submits that Applicant's claims 1-8 and 10-28 are patentable under 35 U.S.C. § 102. The Appellant respectfully requests that the Board of Patent Appeals overturn the final rejection of those claims at least for the reasons discussed below.

A. **Claim Rejections - 35 U.S.C. § 102(b)**

Claims 1-8 and 10-28 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Gottfreid* (U.S. Patent No. 6,076,076). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of

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the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the *Gottfreid* reference. Applicant discusses the *Gottfreid* disclosure and Applicant's claims in the following.

1.   The *Gottfreid* Disclosure

Gottfreid discloses a system and method for providing prepaid printing services using a remote computer 12 operated by a user and a host computer 14, where the host computer 14 transfers application software and printer drivers to the remote computer 12 which installs a prepaid print card (PPC) option on a printer menu of the remote computer 12. *See* cols. 4-5, lines 65-8. Accordingly, for a document that "has already been composed on the computer 12," "selection of the option 22 [which is the PPC option] in FIG. 3 brings up the screen illustrated in FIG. 4, which has selection criteria 25." Col. 5, lines 9-13. After selection criteria has been selected, such as "paper size, number of copies, orientation," etc., then a print preview option 27 may also be selected. Then, after a send option 33, 36, 41 is activated, "various other computer and/or data bases may be utilized to process the information for debiting, invoicing, pricing, document composition, and the like. For example, "computer 12 utilizes a transport layer, such as e-mail, to electronically transfer the order to the host 14." Col. 5, lines 25-37. Then, a loading station 51 depending upon the order information transmitted either selects a sheet plant 52 or a web plant 53 for imaging the documents to be printed. "If the sheet plant 52 is selected, then the order passes through a network server or servers 54 which then effect appropriate imaging of documents, such as by different types of electronic imaging stations as illustrated schematically at 55 and 56 in FIG. 1." Col. 6, lines 20-30. "If a web plant 53 is selected, the document will be further

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electronically composed at a composition station computer 65, which through various sequencing programs, orders, outputs, and in position 66 communicates with a computer to plate image setter 67 to produce a printing plate 68 (e.g. an offset plate). This is used with a conventional printing press 69 to image documents." The final documents imaged, either at 55, 56, or 69, are sent to a shipping station, as illustrated schematically at 71 in FIG. 1. Col. 6 lines 42-51.

2. Applicant's Claims

Pritchard fails to teach several of Applicant's claim limitations. Applicant discusses some of those claim limitations in the following.

a. Claims 1-8 and 28

Applicant's independent claim 1 provides as follows (emphasis added):

> A method comprising:
> *receiving, via at least one network service, imaging data that is to be included in a booklet;*
> *receiving, via said at least one network service, user input for incorporating the imaging data into the booklet;*
> *building, via said at least one network service, a booklet incorporating imaging data in accordance with said user input; and*
> *printing the booklet on a network-accessible printer designated by user input.*

Accordingly, with respect to the above teachings of *Gottfreid*, the claimed features of "receiving, <u>via at least one network service</u>, imaging data that is to be included in a booklet," "receiving, <u>via said at least one network service</u>, user input for incorporating the imaging data into the booklet," and "building, <u>via said at least one network service</u>, a booklet incorporating imaging data in accordance with said user input," are not taught or suggested by *Gottfreid*, since *Gottfreid* diversely teaches that a remote computer 12 operated by a user--which is remote from network servers 54 and host computer 14--performs one or more of the above

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features. As such, the remote computer 12 is not a network server and does not provide network services. Rather, it appears to be a client machine of a user. For at least these reasons, *Gottfreid* does not anticipate claim 1.

Additionally, *Gottfreid* fails to teach or suggest "printing the booklet on a network-accessible printer designated by user input," as recited in the claim. As described above, *Gottfreid* discloses that a user is unable to designate a network-accessible printer to be used in printing a booklet. Rather, the user activates a print option which activates software that facilitates preparation of a print order, where a loading station 52 later determines whether a sheet plant 52 or a web plant 53 is used to image the documents to be printed. For at least this reason, *Gottfreid* fails to teach or suggest "printing the booklet on a network-accessible printer designated by user input." Accordingly, *Gottfreid* does not anticipate claim 1 for at least this additional reason.

Accordingly, claim 1 and claims 2-8 and 28 (which depend from claim 11) are allowable over *Gottfreid*, for at least that reason.

Regarding the Advisory Action, it iterates that "Gottfreid states that the 'host computer 14 typically provides central banker, verification, and order status functions, and may provide for debiting of the prepaid print card PPC) 10 or diskette 11.' These functions of the host computer 14 can be considered as 'services', therefore the host computer 14 can be considered as a network service, as currently recited in the claim language." Advisory Action, page 2. For the sake of argument, if the above statements are assumed to be accurate, *Gottfreid* still fails to teach or suggest a network service that provides imaging data, provides user input, and builds a booklet in a manner described in claim 1.

The Advisory Action also states with regard to *Gottfreid* that "the user selects assorted criteria which are included in the print job, as seen in Fig. 4. This selection criteria is used to designate which printing device is used to print the job (either a web printer or a sheet

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printer". Therefore, Gottfreid can be interpreted as teaching of printing the booklet on a network accessible printer designated by user input." Advisory Action, page 2. Applicant respectfully submits that the use of selection criteria to designate a printing device by another entity other than the user is not the same as a user designating a printing device in a manner described in claim 1.

For at least these reasons, the rejections should be withdrawn.

b.   Claims 10-13

Applicant's independent claim 10 provides as follows (emphasis added):

> One or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors, cause the processors to:
> **send content to a client device for execution by a client browser, said content enabling the client device to:**
> display a user interface that is configured to enable a user to select imaging data for use in building a booklet;
> provide, over a network, a user selection of imaging data for use in building the booklet;
> provide, over the network, user input for incorporating the imaging data into the booklet; and
> **provide, over the network, user input for designating a network location for printing the booklet.**

Applicants respectfully submit that independent claim 10 is allowable for at least the reason that *Gottfreid* does not disclose, teach, or suggest at least "provide, over the network, user input for designating a network location for printing the booklet," as recited and emphasized above in claim 10.

Rather, *Gottfreid* discloses at most a system for providing prepaid printing services using a remote computer 12 operated by a user and a host computer 14, where the host computer 14 transfers application software and printer drivers to the remote computer 12 which installs a prepaid print card (PPC) option on a printer menu of the remote computer 12. *See* cols. 4-5, lines 65-8. Accordingly, for a document that "has already been composed on

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the computer 12," "selection of the option 22 [which is the PPC option] in FIG. 3 brings up the screen illustrated in FIG. 4, which has selection criteria 25." Col. 5, lines 9-13. After selection criteria has been selected, such as "paper size, number of copies, orientation," etc., then a print preview option 27 may also be selected. Then, after a send option 33, 36, 41 is activated, "various other computer and/or data bases may be utilized to process the information for debiting, invoicing, pricing, document composition, and the like. For example, "computer 12 utilizes a transport layer, such as e-mail, to electronically transfer the order to the host 14." Col. 5, lines 25-37. Then, a loading station 51 depending upon the order information transmitted either selects a sheet plant 52 or a web plant 53 for imaging the documents to be printed. "If the sheet plant 52 is selected, then the order passes through a network server or servers 54 which then effect appropriate imaging of documents, such as by different types of electronic imaging stations as illustrated schematically at 55 and 56 in FIG. 1." Col. 6, lines 20-30. "If a web plant 53 is selected, the document will be further electronically composed at a composition station computer 65, which through various sequencing programs, orders, outputs, and in position 66 communicates with a computer to plate image setter 67 to produce a printing plate 68 (e.g. an offset plate). This is used with a conventional printing press 69 to image documents." The final documents imaged, either at 55, 56, or 69, are sent to a shipping station, as illustrated schematically at 71 in FIG. 1. Col. 6 lines 42-51.

Accordingly, with respect to the above teachings of *Gottfreid*, the claimed features to "send content to a client device for execution by a client browser, said content enabling the client device to: . . ." are not taught or suggested by *Gottfreid*, since *Gottfreid* diversely teaches that application software and printer drivers are installed in a remote computer 12 to perform operations associated with composing imaging documents. As such, a client browser

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of the remote computer 12 is not executing these operations. For at least these reasons, *Gottfreid* does not anticipate claim 10.

Additionally, *Gottfreid* fails to teach or suggest to "provide, over the network, user input for designating a network location for printing the booklet," as recited in the claim. As described above, *Gottfreid* discloses that a user is unable to designate a network-accessible printer to be used in printing a booklet. Rather, the user activates a print option which activates software that facilitates preparation of a print order, where a loading station 52 later determines whether a sheet plant 52 or a web plant 53 is used to image the documents to be printed. For at least this reason, *Gottfreid* fails to teach or suggest to "provide, over the network, user input for designating a network location for printing the booklet." Accordingly, *Gottfreid* does not anticipate claim 10 for at least this additional reason.

Accordingly, claim 10 and claims 11-13 (which depend from claim 10) are allowable over *Gottfreid*, for at least that reason.

Regarding the Advisory Action, it iterates that "the user selects assorted criteria which are included in the print job, as seen in Fig. 4. This selection criteria is used to designate which printing device is used to print the job (either a web printer or a sheet printer). Therefore, Gottfreid can be interpreted as teaching of printing the booklet on a network accessible printer designated by user input." Advisory Action, page 2. Applicant respectfully submits that the use of selection criteria to designate a printing device by another entity other than the user is not the same as user input designating a network location for printing a booklet in a manner as described in claim 10.

The Advisory Action further states that "'the application and printer drivers are downloaded from the host 14 to the remote computer 12.' This downloaded material can be considered as "content", which is sent to a client device for execution by a client browser." For the sake of argument, if the above statements are assumed to be accurate, *Gottfreid* still

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ils to teach or suggest content execution by a client browser that enables a client device to perform the display the user interface operation, provide a user selection of imaging data operation, provide user input for incorporating the imaging data operation, and provide user input for designating a network location operation in a manner described in claim 10.

For at least these reasons, the rejections should be withdrawn.

c.   Claims 14-17

Applicant's independent claim 14 provides as follows (emphasis added):

> A method comprising:
> causing, via at least one Web service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet;
> *receiving, via said at least one Web service, a user selection of imaging data;*
> *receiving, via said at least one Web service, user input for incorporating the imaging data into a booklet;*
> *building, via said at least one Web service, a booklet incorporating imaging data received from said user input; and*
> *printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user.*

Applicants respectfully submit that independent claim 14 is allowable for at least the reason that *Gottfreid* does not disclose, teach, or suggest at least the feature of "receiving, via said at least one Web service, a user selection of imaging data," "receiving, via said at least one Web service, user input for incorporating the imaging data into a booklet," "building, via said at least one Web service, a booklet incorporating imaging data received from said user input," and "printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user," as recited and emphasized above in claim 14.

Accordingly, with respect to the above teachings of *Gottfreid*, the claimed features of "receiving, via said at least one Web service, a user selection of imaging data," "receiving, via said at least one Web service, user input for incorporating the imaging data into a booklet," or building, via said at least one Web service, a booklet incorporating imaging data

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 received from said user input" are not taught or suggested by the cited art, since *Gottfreid* teaches that a remote computer 12 operated by a user--which is remote from network servers 58 and host computer 14--performs one or more of the above features. As such, the remote computer 12 is not a network or Web server and does not provide network or Web services. Rather, it appears to be a client machine of a user. For at least these reasons, *Gottfreid* does not anticipate claim 14.

Additionally, *Gottfreid* fails to teach or suggest "printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user," as recited in the claim. As described above, *Gottfreid* discloses that a user is unable to designate a network-accessible printer to be used in printing a booklet. Rather, the user activates a print option which activates software that facilitates print order to be prepared, where a loading station 52 later determines whether a sheet plant 52 or a web plant 53 is used to image the documents to be printed. For at least this reason, *Gottfreid* fails to teach or suggest "printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user." Accordingly, *Gottfreid* does not anticipate claim 14 for at least this additional reason.

Accordingly, claim 14 and claims 15-17 (which depend from claim 14) are allowable over *Gottfreid*, for at least that reason.

Regarding the Advisory Action, it iterates that "Gottfreid states that the 'host computer 14 typically provides central banker, verification, and order status functions, and may provide for debiting of the prepaid print card PPC) 10 or diskette 11.' These functions of the host computer 14 can be considered as 'services', therefore the host computer 14 can be considered as a network service, as currently recited in the claim language." Advisory Action, page 2. For the sake of argument, if the above statements are assumed to be accurate, *Gottfreid* still fails to teach or suggest a Web service that provides user selection of imaging data, provides user input, builds a booklet, and prints the booklet in a manner described in claim 1.

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The Advisory Action also states with regard to *Gottfreid* that "the user selects assorted criteria which are included in the print job, as seen in Fig. 4. This selection criteria is used to designate which printing device is used to print the job (either a web printer or a sheet printer). Therefore, Gottfreid can be interpreted as teaching of printing the booklet on a network accessible printer designated by user input." Advisory Action, page 2. Applicant respectfully submits that the use of selection criteria to designate a printing device by another entity other than the user is not the same as a user designating a Web-accessible printer in a manner described in claim 14.

For at least these reasons, the rejections should be withdrawn.

d.   Claims 18-21

Applicant's independent claim 18 provides as follows (emphasis added):

> A method comprising:
> *receiving, via at least one Web service, a user selection of imaging data that is to be used to build a booklet;*
> *receiving, via said at least one Web service, user input for incorporating the imaging data into the booklet;*
> *receiving, via said at least one Web service, user input for designating a network device for printing the booklet; and*
> *building, via said at least one Web service, a booklet incorporating imaging data received from said user input.*

Applicants respectfully submit that independent claim 18 is allowable for at least the reason that *Gottfreid* does not disclose, teach, or suggest at least the feature of "receiving, via at least one Web service, a user selection of imaging data that is to be used to build a booklet," "receiving, via said at least one Web service, user input for incorporating the imaging data into the booklet," "receiving, via said at least one Web service, user input for designating a network device for printing the booklet," or "building, via said at least one Web service, a booklet incorporating imaging data received from said user input," as recited and emphasized above in claim 18.

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Accordingly, with respect to the above teachings of *Gottfreid*, the claimed features of "receiving, via at least one Web service, a user selection of imaging data that is to be used to build a booklet," "receiving, via said at least one Web service, user input for incorporating the imaging data into the booklet," "receiving, via said at least one Web service, user input for designating a network device for printing the booklet," or "building, via said at least one Web service, a booklet incorporating imaging data received from said user input" are not taught or suggested by the cited art, since *Gottfreid* teaches that a remote computer 12 operated by a user--which is remote from network servers 54 and host computer 14--performs one or more of the above features. As such, the remote computer 12 is not a network or Web server and does not provide network or Web services. Rather, it appears to be a client machine of a user. For at least these reasons, *Gottfreid* does not anticipate claim 18.

Accordingly, claim 18 and claims 19-21 (which depend from claim 18) are allowable over *Gottfreid*, for at least that reason.

Regarding the Advisory Action, it iterates that "Gottfreid states that the 'host computer 14 typically provides central banker, verification, and order status functions, and may provide for debiting of the prepaid print card PPC) 10 or diskette 11.' These functions of the host computer 14 can be considered as 'services', therefore the host computer 14 can be considered as a network service, as currently recited in the claim language." Advisory Action, page 2. For the sake of argument, if the above statements are assumed to be accurate, *Gottfreid* still fails to teach or suggest a Web service that provides user selection of imaging data, provides user input for incorporating the imaging data, provides user input for designating a network device, and builds a booklet in a manner described in claim 18.

The Advisory Action also states with regard to *Gottfreid* that "the user selects assorted criteria which are included in the print job, as seen in Fig. 4. This selection criteria is used to designate which printing device is used to print the job (either a web printer or a sheet

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printer). Therefore, Gottfreid can be interpreted as teaching of printing the booklet on a network accessible printer designated by user input." Advisory Action, page 2. Applicant respectfully submits that the use of selection criteria to designate a printing device by another entity other than the user is not the same as a user designating a network device in a manner described in claim 18.

For at least these reasons, the rejections should be withdrawn.

e. Claim 22

Applicant's independent claim 22 provides as follows (emphasis added):

> One or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors, cause the processors to:
> *receive, via at least one Web service, a user selection of imaging data that is to be used to build a booklet;*
> *receive, via said at least one Web service, user input for incorporating the imaging data into the booklet;*
> *receiving, via said at least one Web service, user input for designating a network device for printing the booklet;* and
> *build, via said at least one Web service, a booklet incorporating imaging data received from said user input.*

Applicants respectfully submit that independent claim 22 is allowable for at least the reason that *Gottfreid* does not disclose, teach, or suggest at least the feature to "receive, via at least one Web service, a user selection of imaging data that is to be used to build a booklet," "receive, via said at least one Web service, user input for incorporating the imaging data into the booklet," "receiving, via said at least one Web service, user input for designating a network device for printing the booklet," or "build, via said at least one Web service, a booklet incorporating imaging data received from said user input," as recited and emphasized above in claim 22.

Accordingly, with respect to the above teachings of *Gottfreid*, the claimed features to "receive, via at least one Web service, a user selection of imaging data that is to be used to

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build a booklet," "receive, <u>via said at least one Web service</u>, user input for incorporating the imaging data into the booklet," "receiving, <u>via said at least one Web service</u>, user input for designating a network device for printing the booklet," or "build, <u>via said at least one Web service</u>, a booklet incorporating imaging data received from said user input," are not taught or suggested by the cited art, since *Gottfreid* teaches that a remote computer 12 operated by a user--which is remote from network servers 54 and host computer 14--performs one or more of the above features. As such, the remote computer 12 is not a network or Web server and does not provide network or Web services. Rather, it appears to be a client machine of a user. For at least these reasons, *Gottfreid* does not anticipate claim 22.

Regarding the Advisory Action, it iterates that "Gottfreid states that the 'host computer 14 typically provides central banker, verification, and order status functions, and may provide for debiting of the prepaid print card PPC) 10 or diskette 11.' These functions of the host computer 14 can be considered as 'services', therefore the host computer 14 can be considered as a network service, as currently recited in the claim language." Advisory Action, page 2. For the sake of argument, if the above statements are assumed to be accurate, *Gottfreid* still fails to teach or suggest a Web service that provides a user selection of imaging data, provides user input for incorporating the imaging data, provides user input for designating a network device, and builds a booklet in a manner described in claim 22.

The Advisory Action also states with regard to *Gottfreid* that "the user selects assorted criteria which are included in the print job, as seen in Fig. 4. This selection criteria is used to designate which printing device is used to print the job (either a web printer or a sheet printer). Therefore, Gottfreid can be interpreted as teaching of printing the booklet on a network accessible printer designated by user input." Advisory Action, page 2. Applicant respectfully submits that the use of selection criteria to designate a printing device by another

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entity other than the user is not the same as a user designating a network device in a manner described in claim 22.

For at least these reasons, the rejections should be withdrawn.

f. Claims 23-24

Applicant's independent claim 23 provides as follows (emphasis added):

> A booklet-making method comprising:
> *browsing to a Web-accessible booklet-making service;*
> *specifying to said Web-accessible booklet-making service imaging data that is to be used to make a booklet and how that imaging data is to be used;*
> *constructing, via said Web-accessible booklet-making service, a booklet incorporating the imaging data; and*
> *forwarding, from said Web-accessible booklet-making service, the booklet to a network printer designated by a user.*

Applicants respectfully submit that independent claim 23 is allowable for at least the reason that *Gottfreid* does not disclose, teach, or suggest at least the feature of "browsing to a Web-accessible booklet-making service," "specifying to said Web-accessible booklet-making service imaging data that is to be used to make a booklet and how that imaging data is to be used," "constructing, via said Web-accessible booklet-making service, a booklet incorporating the imaging data," or "forwarding, from said Web-accessible booklet-making service, the booklet to a network printer designated by a user," as recited and emphasized above in claim 23.

With respect to the above teachings of *Gottfreid*, the claimed features of "browsing to a Web-accessible booklet-making service," "specifying to said Web-accessible booklet-making service imaging data that is to be used to make a booklet and how that imaging data is to be used," "constructing, via said Web-accessible booklet-making service, a booklet incorporating the imaging data," or "forwarding, from said Web-accessible booklet-making service, the booklet to a network printer designated by a user," are not taught or suggested by

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the cited art, since *Gottfreid* teaches that a remote computer 12 operated by a user, which is remote from network servers 54 and host computer 14, performs one or more of the above features. As such, the remote computer 12 is not a network server and does not provide network or web services. Rather, it appears to be a client machine of a user. For at least these reasons, *Gottfreid* does not anticipate claim 23.

Accordingly, claim 23 and claim 24 (which depends from claim 23) are allowable over *Gottfreid*, for at least that reason.

Regarding the Advisory Action, it states with regard to *Gottfreid* that "the user selects assorted criteria which are included in the print job, as seen in' Fig. 4. This selection criteria is used to designate which printing device is used to print the job (either a web printer or a sheet printer). Therefore, Gottfreid can be interpreted as teaching of printing the booklet on a network accessible printer designated by user input." Advisory Action, page 2. Applicant respectfully submits that the use of selection criteria to designate a printing device by another entity other than the user is not the same as a user designating a network printer in a manner described in claim 23.

For at least these reasons, the rejections should be withdrawn.

g. Claims 25-27

Applicant's independent claim 25 provides as follows (emphasis added):

> A web service comprising:
> *means, operably associated with the Web, for enabling a user to specify one or more Web-accessible documents for use in building a booklet;*
> *means, operably associated with the Web, for enabling the user to specify one or more pages from the one or more documents and where said one or more pages will reside in the booklet;*
> *means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet;* and
> *means, operably associated with the Web, for building the booklet.*

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Applicants respectfully submit that independent claim 25 is allowable for at least the reason that *Gottfreid* does not disclose, teach, or suggest at least the feature of "means, operably associated with the Web, for enabling a user to specify one or more Web-accessible documents for use in building a booklet; means, operably associated with the Web, for enabling the user to specify one or more pages from the one or more documents and where said one or more pages will reside in the booklet; means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet; and means, operably associated with the Web, for building the booklet," as recited and emphasized above in claim 25.

With respect to the above teachings of *Gottfreid*, the claimed features of "means, operably associated with the Web, for enabling a user to specify one or more Web-accessible documents for use in building a booklet; means, operably associated with the Web, for enabling the user to specify one or more pages from the one or more documents and where said one or more pages will reside in the booklet; means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet; and means, operably associated with the Web, for building the booklet," are not taught or suggested by the cited art, since *Gottfreid* teaches that a remote computer 12 operated by a user, which is remote from network servers 54 and host computer 14, performs one or more of the above features. As such, the remote computer 12 is not a network server and does not provide network or web services. Rather, it appears to be a client machine of a user. For at least these reasons, *Gottfreid* does not anticipate claim 25.

Accordingly, claim 25 and claim 26-27 (which depend from claim 25) are allowable over *Gottfreid*, for at least that reason.

Regarding the Advisory Action, it states with regard to *Gottfreid* that "the user selects assorted criteria which are included in the print job, as seen in Fig. 4. This selection criteria

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is used to designate which printing device is used to print the job (either a web printer or a sheet printer). Therefore, Gottfreid can be interpreted as teaching of printing the booklet on a network accessible printer designated by user input." Advisory Action, page 2. Applicant respectfully submits that the use of selection criteria to designate a printing device by another entity other than the user is not the same as a user designating a network printer in a manner described in claim 25.

For at least these reasons, the rejections should be withdrawn.

3. Summary

Due to the shortcomings of the *Gottfreid* reference described in the foregoing, Applicant respectfully asserts that *Gottfreid* does not anticipate Applicant's claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

VIII. Conclusion

In summary, it is Applicant's position that Applicant's claims are patentable over the applied cited art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

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<u>**Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)**</u>

The following are the claims that are involved in this Appeal.

1. A method comprising:

receiving, via at least one network service, imaging data that is to be included in a booklet;

receiving, via said at least one network service, user input for incorporating the imaging data into the booklet;

building, via said at least one network service, a booklet incorporating imaging data in accordance with said user input; and

printing the booklet on a network-accessible printer designated by user input.

2. The method of claim 1 further comprising prior to receiving said imaging data, causing, via at least one network service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet, and wherein said receiving imaging data comprises receiving user selection of said imaging data.

3. The method of claim 2, wherein said receiving user selection comprises receiving user selection of multiple documents for use in building said booklet.

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4. The method of claim 2, wherein said receiving user selection comprises receiving user selection of multiple documents for use in building said booklet, said multiple documents being retrievable from a user-associated, network-accessible personal imaging repository and further comprising prior to said building, retrieving, via said at least one network service, said multiple documents from the personal imaging repository.

5. The method of claim 2, wherein said acts of causing, receiving user selection, and receiving user input are respectively performed by multiple network services.

6. The method of claim 1, wherein said at least one network service is implemented, at least in part, by at least one printer.

7. The method of claim 1, wherein said at least one network service is implemented, at least in part, by at least one proxy server that serves as a proxy for at least one printer.

8. The method of claim 1 further comprising saving the booklet, via said at least one network service, in a personal imaging repository associated with the user.

9. (Canceled)

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10. One or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors, cause the processors to:

send content to a client device for execution by a client browser, said content enabling the client device to:

display a user interface that is configured to enable a user to select imaging data for use in building a booklet;

provide, over a network, a user selection of imaging data for use in building the booklet;

provide, over the network, user input for incorporating the imaging data into the booklet; and

provide, over the network, user input for designating a network location for printing the booklet.

11. One or more computer-readable media as recited in claim 10, wherein the instructions further cause the one or more processors to save, via the network, a booklet that has been built based on the user's input.

12. One or more computer-readable media as recited in claim 10, wherein the instructions further cause the one or more processors to print, via the network, the booklet on one or more network accessible printers.

13. One or more computer-readable media as recited in claim 10, wherein the instructions further cause the one or more processors to provide said user selection and said user input over a network comprising the Internet.

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14. A method comprising:

causing, via at least one Web service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet;

receiving, via said at least one Web service, a user selection of imaging data;

receiving, via said at least one Web service, user input for incorporating the imaging data into a booklet;

building, via said at least one Web service, a booklet incorporating imaging data received from said user input; and

printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user.

15. The method of claim 14 further comprising saving the booklet, via said at least one Web service, in a Web-accessible location.

16. The method of claim 14 wherein said at least one Web service is implemented, at least in part, by at least one printer.

17. The method of claim 14 wherein said at least one network service is implemented, at least in part, by at least one proxy server that serves as a proxy for at least one printer.

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18. A method comprising:

receiving, via at least one Web service, a user selection of imaging data that is to be used to build a booklet;

receiving, via said at least one Web service, user input for incorporating the imaging data into the booklet;

receiving, via said at least one Web service, user input for designating a network device for printing the booklet; and

building, via said at least one Web service, a booklet incorporating imaging data received from said user input.

19. The method of claim 18 further comprising providing the user, via said at least one Web service, options to print the booklet on at least one Web-accessible printer and saving the booklet in a Web-accessible location.

20. The method of claim 18, wherein said at least one Web service is implemented, at least in part, by a Web-accessible printer.

21. The method of claim 18, wherein said at least one Web service is implemented, at least in part, by at least one proxy server that serves as a proxy for at least one printer.

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22. One or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors, cause the processors to:

receive, via at least one Web service, a user selection of imaging data that is to be used to build a booklet;

receive, via said at least one Web service, user input for incorporating the imaging data into the booklet;

receiving, via said at least one Web service, user input for designating a network device for printing the booklet; and

build, via said at least one Web service, a booklet incorporating imaging data received from said user input.

23. A booklet-making method comprising:

browsing to a Web-accessible booklet-making service;

specifying to said Web-accessible booklet-making service imaging data that is to be used to make a booklet and how that imaging data is to be used;

constructing, via said Web-accessible booklet-making service, a booklet incorporating the imaging data; and

forwarding, from said Web-accessible booklet-making service, the booklet to a network printer designated by a user.

24. The method of claim 23 further comprising printing the booklet via the Web-accessible booklet-making service.

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25. A web service comprising:

means, operably associated with the Web, for enabling a user to specify one or more Web-accessible documents for use in building a booklet;

means, operably associated with the Web, for enabling the user to specify one or more pages from the one or more documents and where said one or more pages will reside in the booklet;

means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet; and

means, operably associated with the Web, for building the booklet.

26. The web service of claim 25 further comprising means for printing the booklet.

27. The web service of claim 25 further comprising means for saving the booklet in a personal imaging repository associated with the user.

28. The method of claim 1 further comprising prompting a user to choose a network-accessible printer for printing the booklet from a plurality of available network-accessible printers.

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Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

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Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.

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